UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,034	04/10/2001	Sudesh Kamath	ORCL5665CIP (OID-2000-128	8354

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EXAMINER
VIG, NARESH

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/833,034	KAMATH ET AL.
	Examiner	Art Unit
	Naresh Vig	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 December 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1, 3 – 7, 9 – 24, 26 – 30, 32 – 47, 49 – 53 and 55 – 69</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1, 3 – 7, 9 – 24, 26 – 30, 32 – 47, 49 – 53 and 55 – 69</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20050630</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

This is in reference to the communication mailed on 09 December 2005. There are 63 claims, claims 1, 3 – 7, 9 – 24, 26 – 30, 32 – 47, 49 – 53 and 55 – 69 pending for examination.

Priority

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In claims 1, 24 and 47 applicant recites "responsive to receiving the first online request, providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route" which is not supported by the US Application 09/645,460 for which the applicant is claiming priority of. The priority date of this application will be the 10 April 2001, the date on which the application was originally filed.

Response to Arguments

In response to applicant's argument that cited references taken alone or in combination does not teach or suggest bifurcated order processing route. However, applicant has not clearly defined bifurcated order processing route in the application originally filed on 10 April 2001.

In response to applicant's argument that there is no teaching or suggestion in cited references of applying 1-click model to the contents of the shopping cart. However, cited reference Hartman teaches plurality of items in an order for 1-click order processing [Fig. 1C]. Applicant is claiming customer to choose first order processing route or a second order processing route. Examiner has elected first order processing route which is disclosed by cited references.

In response to applicant's argument that cited references do not teach automatic checking out of the shopping cart. Applicant is arguing the limitation not claimed by the applicant.

Applicants arguments and concerns are responded to in response to the claims below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 24 and 47 recites the limitation "responsive to the first online request".

There is insufficient antecedent basis for this limitation in the claim. For the purpose of

examination, examiner reads the limitation as "responsive to the first online purchase

request".

Regarding claims 12 – 13, 35 – 36 and 58 – 59 recite the limitation "wherein the

enabling step allows at least one of the customer, a selected process and at least one

authorized person to modify the first quote". Examiner does not understand the Markush

group as claimed by the applicant. For the purpose of examination, examiner reads the

limitation as "wherein the enabling step allows at least one of the customer, a selected

process and a authorized person to modify the first quote".

Claim Rejections - 35 USC § 102

> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3 – 5, 9 – 24, 26 – 28, 32 – 47, 49 – 51 and 55 – 69 are rejected under

35 U.S.C. 102(a) as being unpatentable over Barnes & Noble hereinafter known as

B&N (additional pages added to B&N reference presented earlier).

Regarding claims 1, 24 and 47, B&N teaches system and method of processing

an online purchase request from a customer to a vendor. B&N teaches express

checkout button on web page [page 12, 13]. B&N teaches:

receiving a first online purchase request for a first item [page 12, 13, 37];

responsive to receiving the first online request, providing a bifurcated order

processing route that requests the customer to choose a first order processing route

(Express Checkout) or a second order processing route (Shopping Cart) [page 12, 13,

28, 37],

the first order processing route causing the first online purchase request to be

processed according to an express processing procedure that requires no further input

by the customer to execute the first online purchase request [page 12, 13, 37],

B&N teaches:

website www.BarnesAndNoble.com.:

at least one processor (B&N server);

at least one data storage device (B&N teaches to store account information);

a plurality of processes spawned by said at least one processor (B&N teaches to

allow customers to perform plurality of functions on their web site, capability for plurality

of customers to access B&N system).

a machine-readable medium having data stored thereon representing sequences

of instructions which, when executed by computing device, causes said computing

device to process an online purchase request from a customer to a vendor (a computer

is required to load the instructions from machine-readable medium to function as intended by the business. For example, CDROM, ROM, RAM, Flash Memory, Floppy diskette etc. which have sequence of instructions stored on them to allow the computer to read information from during the initial program load).

Applicant is receiving the purchase order request for the first item, and, responsive to receiving first online request, applicant provides bifurcated order processing route. Applicant is just receives the purchase request from the user is non-functional data because applicant does not does not claim how the purchase request data is used to fulfill the purchase order request received from the user.

In addition, applicant does not claim the limitation on how the purchase request is received from the user. It is not clear whether the user uses a telephone to make a purchase request, applicant provides an web page using which applicant makes a purchase request, applicant sends in a fax or a purchase order to make a purchase request

Regarding claims 3, 26 and 49, B&N teaches enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and use [page 12, 37].

Regarding claims 4, 27 and 50, B&N teaches first item includes a uniquely identified and pre-stored list of goods [page 12, 13, 37].

Regarding claims 5, 28 and 51, B&N teaches list (shopping cart) includes an object, the object including at least one of another list and item.

Regarding claims 9, 32 and 55, B&N in view of Hartman teaches:

generating a first quote that includes the processed first online purchase request, the first quote including at least one of an identification of the first item and an identification of the shopping cart [page 12];

enabling modifications to be made to the first quote, the first quote persisting at least until a consolidation interval has elapsed (How to remove or change items in your cart) [page 12];

carrying out the converting step by converting the first quote into the first executable order when a quote conversion process determines that the first quote has remained unmodified at least for the consolidation interval (you have 90 minutes to make any changes) [page 12].

Regarding claims 10, 33 and 56, B&N teaches generating an order status Web page that is viewable by the customer, the order status Web page displaying selected details of the first quote (how can I check on my order) [page 24].

Regarding claims 11, 34 and 57, B&N teaches order status Web page is configured to refer to the first quote as a pending order (how can I check on my order) [page 24].

Regarding claims 12, 35 and 58, B&N teaches to allow customer to modify the first quote.

Regarding claims 13, 36 and 59, B&N teaches authorized person includes the customer.

Regarding claims 14, 37 and 60, B&N teaches quote conversion process is launched at a selectable interval (hold to complete) [page 14].

Regarding claims 15, 38 and 61, B&N teaches consolidation interval is measured from a time at which the quote conversion process is launched (hold to complete) [page 14].

Regarding claims 16, 39 and 62, B&N teaches quote conversion process runs continuously (hold to complete) [page 14].

Regarding claims 17, 40 and 63, B&N teaches converting the first and any second purchase request into an executable order and sending the executable order to an order fulfillment system (hold to complete) [page 14].

Regarding claims 18, 41 and 64, B&N teaches receiving a second online purchase request for a second item from the customer, and adding the second item to the first quote when the second online purchase request is received before the first quote is converted into the first order (hold to complete) [page 14].

Regarding claims 19, 42 and 65, B&N teaches receiving a second online purchase request for a second item from the customer, and adding the second item to the first quote when the quote conversion process determines that the first quote has remained unmodified for a period of time that is less than the consolidation interval [page 14, 24].

Regarding claim 20, 43 and 66, B&N teaches receiving a second online purchase request for a second item from the customer, and generating a second quote that includes an identification of the second item and the retrieved information when the quote conversion process determines that the first quote has remained unmodified for a period of time greater than the consolidation interval [page 14, 24].

Regarding claims 21, 44 and 67, B&N teaches quote conversion process determines a difference between a time at which a last modification to the first quote was made and a current time and converts the quote to the first order when the difference is greater than the consolidation interval [page 14, 24].

Regarding claim 22, 45 and 68, B&N teaches sending a message to the customer when the first quote is converted into the first order (confirmation email) [page 28].

Regarding claims 23, 46 and 69, B&N in view of Hartman teaches message includes an email (confirmation email) [page 28].

Claims 6, 29 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes & Noble hereinafter known as B&N (additional pages added to B&N reference presented earlier)in view of Kawashima et al. US Patent 5,168,445 hereinafter known as Kawashima.

Regarding claims 6, 29 and 52, on page 5, line 8 of the application originally filed on 01 April 2001, applicant recites "The first online purchase request may be received from an automated process configured to generate the first online purchase request at a selectable date and/or interval". However, Kawashima teaches automated ordering system for purchase request at selectable date and time interval.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify B&N as taught by Kawashima for managing inventory to meet market demands by minimizing goods being in great demand

frequently become out of stock frequently while goods being in low demand are stocked

in surplus.

Claims 6, 29 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Barnes & Noble hereinafter known as B&N (additional pages added to B&N

reference presented earlier)in view of Johnson et al. US Patent 5,712,989 hereinafter

known as Johnson.

Regarding claims 7, 30 and 53, B&N does not teach customer identifies the first

item using a unique identifier used by the customer and wherein the vendor maps the

identifier used by the customer to a corresponding unique identifier used by the vendor.

However, Johnson teaches capability where customer identifies the first item using a

unique identifier used by the customer and wherein the vendor maps the identifier used

by the customer to a corresponding unique identifier used by the vendor [Johnson, Fig.

3 and disclosure associated with Fig. 3]

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify B&N in view of Hartman to handle alternate

product numbers to enable the method and system to handle OEM clients.

Conclusion

Applicant is required under 37 CRF '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig
Examiner
Art Unit 3629

February 1, 2006